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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/233,860 01/20/99 HUTCHINSON

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EXAMINER

THOMSON, W

ART UNIT

PAPER NUMBER

2763

DATE MAILED:

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Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/233,860

Applicant(s)
Hutchinson et al.

Examiner
William Thomson

Group Art Unit
2763



☒ Responsive to communication(s) filed on Feb 14, 2000

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-3, 5-8, 10-13, 15, 16, and 18-24 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-3, 5-8, 10-13, 15, 16, and 18-24 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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DETAILED ACTION

1. Claims 1-3,5-8, 10-13, 15-20 and 21-2~~7~~ have been submitted for examination. Claims 1-3,5-8, 10-13, 15-20 and 21-2~~7~~ have been examined and rejected. um
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Specification

2. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed. Specifically, the title is not descriptive of the applicants invention which appears to be a management system with hardware tracking based on the network card.

Preamble of the Claims

The preamble of the claims presented for examination have not been given any patentable weight. Appropriate weight is given to limitation recited in the body of the claim that are needed for purpose of antecedence. "A mere statement of purpose or intended use in the preamble of a claim need not be considered in finding anticipation; however, it must be considered if the language of a preamble is necessary to give meaning to the claim" *Diversitech Corp. v. Century Steps, Inc.*, 7 USPQ2d 1315 (Fed. Cir. 1988); *In re Stencel*, 4 USPQ2d 1071 (Fed. Cir. 1987)

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Response to Amendments

3. Applicants have amended claims 1, 2, 8, 11, 12, 13, 16, 18, 19, 21 and 23 with the additional limitations directed to “asset-management information about the node...” and “network interface card of the node” with further supportive amendments to the claim language. Claim 24 has been added including these limitation and others. The new art made of record herein is asserted to teach all these amended limitations.

Response to Arguments

4. Applicants’ arguments filed February 14, 2000 have been fully considered but are not persuasive. Applicants’ amendments, including newly presented claim 24, has required a new search of the art and assertion of newly uncovered art made of record herein. The following rejection was necessitated by amendment. THIS ACTION IS MADE FINAL.

5. Examiner withdraws the rejection under 35 U.S.C. 112, 2nd paragraph directed to claims 2 and 15. Applicant has amended accordingly and removed the problem.

6. Applicants have been silent on the rejection of claims 11 and 12 under 35 U.S.C. 112, 4th paragraph, thereby conceding to the rejection. Claims 11 and 12 stand rejected under 35 U.S.C. 112, 2nd paragraph.

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7. Examiner re-asserts the rejections under 35 U.S.C. 112 2nd para. directed to claims 11 and 12. Applicants representative has asserted the position that In re Warmerdam can be used to overcome the rejection. Examiner respectfully disagrees. The facts in Warmerdam are similar and so is the claims language and structure, however, merely being similar in there nature does not mean they are equivalent in their nature. Specifically looking at the claim language of Warmerdam:

“A machine having a memory which contains data representing a bubble hierarchy generated by the method of any of Claims 1 through 4.”

Now take applicants' claim 11 language:

“A program storage device readable by a processor in the client node of a specified one of claims 1 through 3, 5 through 7, and 21 through 24, and encoding a program of instructions including instructions for performing the operations recited in the specified claim as being performed by the client node”

As can be plainly seen the language and the constructs are very different and require a completely different interpretation of the language. The applicants language of “of a specified one of claims 1 through 3” is within the practice and interpretation of the Warmerdam decision. However, that is where the similarity ends. Specifically, applicant continues then uses language separated with a “,” and then a new series of claims “5 through 7”, the conjunctive “and” and then finally a new series of claims “21 through 24”. Finally, applicants have added further

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limitations to the claims with “encoding a program of instructions including instructions for performing the operations recited in the specified claim as being performed by the client node”.

Examiner proffers that this is not within the scope, meaning and reasonable interpretation of *In re Warmerdam* decision. Further, the additional limitations provide an ambiguity to the claim language in a way as to make proper and reasonable interpretation of the language impossible.

The person that is one skilled in the art would have a particular difficulty in determining whether or not that person was infringing upon any one of the permutations of the claim language that could be reasonably inferred from the ambiguous language as applicant has claimed.

Therefore the language as applicant has provided is clearly indefinite in nature and defective.

Claim 12 is constructed in the same fashion and therefor has the same ambiguities, is indefinite and defective.

Examiner will also point out the functional difficulties applicants’ style of claim language provides. Firstly, the claim 11 can not be examined, allowed or rejected in total. The mere use of this format makes rejecting and allowing sub-parts difficult if not impossible. Applicants merely needed to restate the claims in conventional independent and respective dependencies to make them individually and/or together allowable or rejectable in view of the art of record. The applicant has been assessed a surcharge for this type of multiple dependent claim language.

Applicants’ permutation deviates from the standard method of claiming multi dependent claims and causes new issues when attempting to interpret the proper scope and limitations of the claim language as currently proffered as acceptable. Examiner does not agree with the applicants’

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opining that claims 11 and 12 are “also a ‘good thing’ on policy grounds because they promote judicial economy. Such claims can be asserted against a vender of ‘infringing’ software as a direct infringer without the patent owner to prove the extra elements required for active inducement of infringement or contributory infringement. Such claims therefore help conserve resources, both for litigants and for the judicial system”. This is without merit and is a mere allegation since it is without evidence. Further, applicants’ approach causes a longer and more difficult prosecution of the instant invention and provides no more than an increase in ambiguity.

Infringement determinations, whether being tested within the Office or in a court of law, would be impossible if applicants’ style of claim language were used. Applicants’ style makes determining the distinctions between inventions or products and the claims within the case difficult if not impossible. Lastly, the examining procedures do not provide for handling such claim language, as applicants have proffered correct, in an effective manner. Primarily, since the style in which applicant is relying upon is not accepted practice. The examiner can not separate the claims to provide applicants with claims that can be dissected for rejection and/or allowance. Claim 12 has the same problems.

Specific Response to Interpretation of Applicants’ Invention

Applicants’ have amended claims to include limitations directed to the operation of an asset management system with locally stored NIC address transfers for updating the configuration files stored on a host machine. Applicants’ specification is directed to storing and transferring

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NIC addresses from one node to another as an updating and tracking system. Prior art teachings of these types of embodiments are not unique. Requests for comments, specifically, RFC 1157, 1187, 1442, 1444, 1450 (SNMP), RFC 1212 MIB-I and RFC 1213 (MIB-II) and related RFCs 1285, 1512, 1748, 1493 and 1643 cover applicants' embodiment as claimed. Further, RFC 1189, directed to CMOT and CMIP cover applicants' enabled embodiment as claimed. Nodes storing multiple instances of MAC addresses is old and well known in the art years prior to applicants' invention. Applicants' appear to be merely retrieving stored management or configuration information from a locally stored file that is sent to another node for reporting the old and new configuration data. These operations are built into the above referenced protocol suites. SNMP or CMIP agents with files are stored at the client side. The manager node needs to know changes in the clients within the managed network. If a change occurs, either the client agent transmits a packet listing the changes in configuration to the management node containing the MIB or the management node sends a "probe" to detect configuration changes stored in the local client files or by scanning the hardware in a routine fashion. Applicants' claimed embodiment performs these specific operations as does the protocol suites detailed in the RFC's listed above. The dates on the RFCs predates applicants' invention by over 5 years. The use of network cards and nodes with multiple MAC addresses or changing MAC address is also well known in the art and have been made of record.

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Claim Rejections - 35 U.S.C. § 112

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 11 and 12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. These claims are written in a manner that does not distinguish them as either method or computer readable medium, but rather some type of hybrid wherein the computer readable medium cannot be clearly correlated to specific method steps. "A program storage device readable by a processor in the node of a specified one of claims 1 through 3, 5 through 7, and 21 through 24, and encoding a program of instructions including instructions for performing the operations recited in said specified claims" and "A program storage device readable by a processor in the server node of a specific one of claims 8, 10 and 24 and encoding a program of instructions including instructions for performing the operations recited in said specified claims" are unclear because a program storage device readable by a processor and encoding a program of instructions for performing the operations cannot be clearly correlated to the method steps. The examiner is left to speculate to the intended meaning of these claims.

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9. The following is a quotation of the forth paragraph of 35 U.S.C. 112:

Subject to the following paragraph, a claim in dependent form shall contain a reference to a claim previously set forth and then specify a further limitation of the subject matter claimed. A claim shall in dependent form shall be construed to incorporate by reference all the limitations of the claim to which it refers.

Claims 11 and 12 are rejected under 35 U.S.C. 112, forth paragraph, for failing to further limit the claim that each depends from. “A program storage device readable by a processor in the node of a specified one of claims 1 through 3, 5 through 7, and 21 through 23, and encoding a program of instructions including instructions for performing the operations recited in said specified claims” and “A program storage device readable by a processor in the server node of a specific one of claims 8 and 10 and encoding a program of instructions including instructions for performing the operations recited in said specified claims” imply the same scope relative to the claims to which each depends. Therefor these dependent claims do not further limit the claims to which each dependent claim refers.

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Claim Rejections - 35 U.S.C. § 102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

11. Claims 1-3,5-8, 10-13 and 15-24 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Barroux and de la Salle. we

Taking claim 1, for example, Barroux and de la Salle disclose:

determining a current address value of a network interface card of the node, referred to as a NIC address value, retrieving from a data storage at the node, a former NIC address value for the node and transmitting asset management information concerning the node together with the current NIC address (MAC address, present configuration). and the former NIC address (MAC address for prior configuration). .

As to claim 2, the method of claim 1, wherein determining the current NIC address includes an attempt to detect the then current NIC address value (MAC address).

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As to claim 3, the method of claim 2, wherein the attempt to detect the current NIC address value is unsuccessful, and further comprising:

retrieving, from a data storage at the node, a stored value containing the result of the past live detection of the then-current NIC address value (current MAC address) referred to as a previously detected NIC address value (last MAC address); and transmitting the previously detected NIC address value (last MAC address) as taught throughout Barroux and de la Salle. (Barroux: SNMP Probe, MAC address, ifPhysAddress object; de la Salle: Board address Object and probe)

Claim 5 recites providing the NIC address value comprises a signature portion and a pseudo randomly generated portion which is the industry standard for generating the MAC addresses stored within the MAC address pool as taught throughout Barroux and de la Salle. (Barroux: SNMP Probe, MAC address, ifPhysAddress object; de la Salle: Board address Object and probe)

Claim 6 recites the use of redundant storage as taught throughout Barroux and de la Salle. (Barroux: SNMP Probe, MAC address, ifPhysAddress object; de la Salle: Board address Object and probe)

Claim 7 recites the use of a time stamping to determine the last NIC address assigned as taught throughout Barroux and de la Salle. (Barroux: SNMP Probe, MAC address, ifPhysAddress object; de la Salle: Board address Object and probe)

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As to claim 13, recites in a node on a network, a data store comprising a machine readable data structure accessible to a processor in the node and containing node-identification for the client node that includes a current network interface card value for the node, referred to as a NIC address value and a former NIC address value as taught throughout Barroux and de la Salle (Barroux: SNMP Probe, MAC address, ifPhysAddress object; de la Salle: Board address Object and probe)

Claims 8, 13, 16, 19, 21-24 are rejected for the same reasoning as claims 1-3 and 6-7, set forth above, supra. Claims 8, 16, 19, 21-24 contain the same limitations as the equivalent claims 1-3 and 6-7 and as taught throughout Barroux and de la Salle.

Claims 10, 15, 18 and 20 are rejected for the same reasoning as claim 5, set forth above, supra. Claims 10, 15, 18 and 20 contain the same limitations as recited in claims 10, 15, 18 and 20 and as taught throughout Barroux and de la Salle.

As for claims 11 and 12 are rejected for the same reasoning as the claims to which they respectively depend, claims 1 through 3, 5 through 7 and 21 through 24 and 8, 10 and 24, respectively, as set forth above, supra. Claims 11 and 12 are interpreted as merely the equivalent computer-readable medium claims containing the same limitations as claims 1 through 3, 5 through 7 and 21 through 23 and 8 and 10, respectively, as taught throughout Barroux and de la Salle.

Applicants are merely claiming the subject matter that is inherent and incorporated within management and configuration systems. Further, cards with

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storage of multiple MAC addresses goes back for years. Anyone of these standard, off the self products (predating applicants' invention at least 4 years) used on a managed network will functions exactly as applicant is attempting to claim. The protocols underlying these operations date back over 5 years prior to applicants' invention.

Applicants' invention is not patentably distinguishable over the prior art of record and the inherent underlying protocols. Further, the courts have held that "A reference anticipates a claim if it discloses the claimed invention such that a skilled artisan could take its teachings in combination with his own knowledge of the particular art and be in possession of the invention.". *In re Gaves*, 36 USPQ2d 1697 (Fed. Cir. 1995); *In re Sase*, 207 USPQ 107 (CCPA 1980); *In re Samour*, 197 USPQ 1 (CCPA 1978). um

Conclusion

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure, careful consideration should be given prior to applicant's response to this Office Action.

U.S. Patents

U.S. Patent 5,982,753 issued to Pendleton et al. discloses a method of testing a LAN using the configuration and management information to determine information including changes in the system.

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U.S. Patent 5,444,850 issued to Chang discloses switching out the network identification of the workstation.

U.S. Patent 5,819,042 issued to Hansen discloses a method and apparatus for guided configuration of un-configured network and internet work devices.

U.S. Patent 5,970,066 issued to Lowry et al. discloses a virtual Ethernet interface with fungible MAC addresses.

U.S. Patent 5,608,720 issued to Biegel et al. discloses a control system and operations system interface for network element in an access system.

U.S. Patent 5,572,528 issued to Shuen discloses a mobile networking method and apparatus including mobile systems associated with multiple network interfaces.

FOREIGN ART:

EPO 0621 705 A2 (1993) discloses a SNMP instrumentation system using a remote SNMP agent for storing and reporting information to the Network Management system.

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13. THIS ACTION IS MADE FINAL. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A SHORTENED STATUTORY PERIOD FOR REPLY TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE MAILING DATE OF THIS ACTION. IN THE EVENT A FIRST REPLY IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 CFR 1.136(A) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT, HOWEVER, WILL THE STATUTORY PERIOD FOR REPLY EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

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14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to William Thomson whose telephone number is (703) 305-0022. The examiner can be usually reached between 9:30 a.m. - 4:00 p.m. Monday thru Friday. Voice mail is checked throughout the day. Please leave a detailed message.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Mr. Kevin Teska, can be reached on 704-305-9704. The fax phone number for this Group is 703-308-1396.

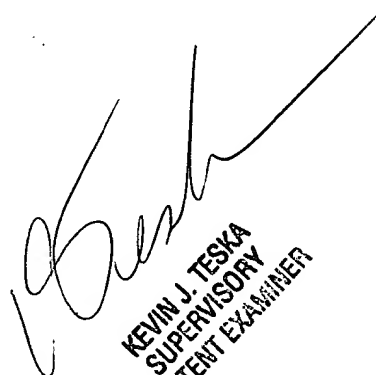
Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is 703-305-3900.

William D. Thomson

Patent Examiner

A.U. 2763

May 4, 2000



KEVIN J. TESKA
SUPERVISORY
PATENT EXAMINER